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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,879	01/05/2001	Christian F. Bayne	D5407-111 304-22404-US	5401
25397	7590	11/05/2004	EXAMINER	
DUANE, MORRIS, LLP 3200 SOUTHWEST FREEWAY Suite 3150 HOUSTON, TX 77027			THOMPSON, KENNETH L	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	BAYNE ET AL.
09/754,879	
Examiner Kenn Thompson	Art Unit 3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on 9 August 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 7,8,12-14 and 20 is/are allowed.
- 6) Claim(s) 1,4-6,9,11 and 15-19 is/are rejected.
- 7) Claim(s) 2,3 and 10 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

The indicated allowability of claims 9 and 17-19 is withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 11, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Meynier, U.S. 5,355,952.

Regarding claim 1, Meynier discloses in figures 2-4 attaching at least one auxiliary conduit (2) to a downhole assembly (5), providing a connection (at 6,7) to the conduit; running in the downhole assembly with the conduit to a desired location in the well; tagging into (6) the downhole assembly and the connection (7) of the conduit downhole on at least one subsequent trip into the well with a tubular (9) having at least one auxiliary cable (10) extending along its length from the surface; communicating (via 4,8,15,16) through the auxiliary conduit between the surface and the downhole assembly on a real time basis.

As to claim 5, Meynier discloses selectively locking any connection (7,8) resulting from the tagging in.

As to claim 6, Meynier discloses configuring the auxiliary cable (10) adjacent the downhole assembly (5) in a manner permitting monitoring.

As to claim 11, Meynier discloses using the auxiliary cable (10) to operate a portion (13) of the downhole assembly.

As to claim 15, Meynier discloses running the auxiliary cable (10) in a U-shaped path (semi circular path at 13) so as to provide a pair of connections, extending the U-shaped path to the surface (via 10) as a result of the tagging, an auxiliary cable attached to a tubular (9) run in from the surface, into a respective connection on a subsequent trip into the wellbore.

As to claim 16, Meynier discloses running in at least one cable (8) and at least one conduit (14) auxiliary to the downhole assembly (5) securing the cable to the conduit.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 4 are rejected under 35 U.S.C. 102(a) as being anticipated by Crawford et al., U.S. 6,464,004.

Regarding claim 1, Crawford et al. discloses in figures 1-5 attaching at least one auxiliary conduit (20) to a downhole assembly (54), providing a connection (22,44) to the conduit; running in the downhole assembly with the conduit to a desired location in the well; tagging into (at 56) the downhole assembly and the connection (22,44) of the conduit downhole on at least one subsequent trip into the well with a tubular having at least one auxiliary cable (32) extending along its length from the surface; communicating through the auxiliary conduit between the surface and the downhole assembly on a real time basis.

As to claim 4, Crawford et al. discloses performing the tagging in (at 56) without rotation.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crawford et al., U.S. 6,464,004 in view of Pringle et al., U.S. 6,237,683.

Regarding claims 9 and 17-19, Crawford et al. discloses an external through (22). Crawford et al. discloses all the claimed subject matter except for the use of fiber optic. Pringle et al. teaches use of fiber optic as one of many communications means (col. 3, lines 7-12). It would have been obvious to one having ordinary skill in the art at the time of the invention to arrange for the communicating cable disclosed by Crawford et al. to be fiber optic as taught by Pringle et al., the use of fiber optic communication means being well known in the art.

***Allowable Subject Matter***

Claims 7, 8, 12-14 and 20 are allowed.

Claims 2, 3, 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record does not disclose or suggest all the claimed subject matter including tagging into the downhole assembly on a subsequent trip with production tubing having at least one auxiliary cable or conduit which is also connectable to the connection of the cable or conduit on the downhole assembly

The prior art of record does not disclose or suggest all the claimed subject matter including plugging the connection during the running in of the downhole assembly and auxiliary cable or conduit; unplugging the connection with another trip into the well.

The prior art of record does not disclose or suggest all the claimed subject matter including using a gravel pack screen and packer for the downhole assembly extending the cable or conduit through the packer to the connection.

The prior art of record does not disclose or suggest all the claimed subject matter including using fiber optic to measure a condition.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenn Thompson whose telephone number is 703 306-5760. The examiner can normally be reached on 7:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on 703 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3672

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

1 November 2004

  
Kenn Thompson  
Primary Patent Examiner  
Art Unit 3672